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REMARKS

Claims 8-11, 13, 14, 20, and 29-37 are currently pending.

Rejection of Claims 8-11, 13, 14, 20, and 29-37 by Nokia Issue EN

The Patent Office rejected claims 8-11, 13, 14, 20, and 29-37 under 35 U.S.C. 103(a) as being unpatentable over Nokia 7650 User's Guide, Issue 4EN, in view of LG, LGVX6000 Manual.

The Patent Office on page 3 of the April 28, 2009 Office Action referred to LG as "LG VX6000 Manual". PDF file created 20 May 2003, the presumed publication date). Applicant requests that the Patent Office verify the actual publication date of LG. If the document existed, but was not in the public domain prior to Applicant's filing date of September 15, 2003, then Applicant requests that the Patent Office remove LG as a reference. In the Office Action dated June 1, 2007, LG is listed on an 892 as "LG VX6000 Cellular Phone Owner's Manual" without any further information such as date of publication. MPEP Section 901.06 states as follows: "All printed publications may be used as references, **the date to be cited being the publication date.**" By not providing an actual, verifiable date of publication, the Patent Office has introduced uncertainty in the patent examination/ prosecution process which could unfavorably limit or deny Applicant's right to a patent.

Claims 20, 29, 31, and 35 are independent claims. Claim 20, as representative of the independent claims, recites as follows:

A computer readable medium encoded with a computer program comprising: program instructions for controlling an electronic device, the electronic device having a digital camera and a user input device, which program instructions when loaded into a processor, provide: a database software application; a camera control software application that is separate from the database software application; and an image viewing software application that is separate from the camera control software application and the database software application, wherein the database software application provides a user interface that enables a user to access personal data organized as a plurality of contacts entries in a database, where each contacts entry is associated with a different person and has one or more alphanumeric text fields and an image field and **wherein the**

camera control software application provides for taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu, the camera control software application providing a user interface that enables the user to control the electronic device using the user input device for displaying the camera menu to capture an image via the digital camera and immediately and automatically presenting a user selectable option through the camera menu, on capturing an image, for entering the database software application while remaining in the camera menu and using the captured image as an image field of a contacts entry of the database, and presenting a user selectable option to access the captured image through the image viewing software application, wherein functionality of the camera menu is provided by the camera control software application and wherein functionality of the phonebook menu is provided by the database software application.

Page 50 of Issue 4EN discloses that “pictures are automatically saved in the Images application, where you can rename them and organise them in folders.” The left margin of page 50 shows that options available before taking a picture are capture, go to images, settings, and exit. Page 51 discloses “the photos are saved automatically in the Images application.” The right margin of page 51 shows that options after a picture has been taken are new image, send, rename image, go to images, settings, and exit. Page 53 of Issue 4EN discloses “images allows you to view, organise, delete, and send photos and pictures stored in your phone.” Issue 4EN does not disclose or suggest “taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu.”

The Patent Office asserted on page 4, lines 8-20, as follows:

the camera control software application providing a user interface that enables the user to control the electronic device using the user input device for displaying the camera menu to capture an image via the digital camera (see page 50, “Camera”) and automatically presenting a user selectable option, on capturing an image, for entering the database software application and using the captured image, for entering the database software application and using the capture image as an image field of a contacts entry of the database (see page 51, “Portrait [...] can be added to a contact card” and see pages 43-44 “Inserting a picture to a contact card”), and presenting a user selectable option to access the captured image through the image viewing software application (see page

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44, "Options when viewing a contact card"), wherein functionality of the camera menu is provided by the camera control software application (see page 50, "Menu -> Camera") and wherein functionality of the phonebook menu is provided by the database software application (see page 42, "Menu -> Contacts").

As to page 51, Issue 4EN discloses camera modes including "portrait when you want to take a smaller icon-sized, vertical picture, which can be added to a contact card." This relied upon disclosure from Issue 4EN fails to teach or suggest the camera control software application "**immediately and** automatically presents a user selectable option, on capturing an image, for entering the database software application and using the captured image as an image field of a contacts entry of the database." As noted above, and as applied here with respect to page 51, Issue 4EN does not disclose or suggest "taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu."

First, the Patent Office has refused to assign patentable weight to the word "immediately" in the claimed subject matter of "immediately and automatically presenting a user selectable option through the camera menu, on capturing an image, for entering the database software application while remaining in the camera menu."

The Patent Office asserted on page 5 of the April 28, 2009 Office Action as follows:

Nokia, as modified, still does not explicitly teach "immediately" presenting an option to use the captured image as an image field of a contacts entry of the database.

However, it would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have further modified Nokia to immediately present such an option upon capturing an image because it would merely provide an automatic means to replace a manual activity which accomplished the same result (see MPEP 2144.04.III and *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)). Furthermore, providing shortcuts for commonly-used features is a well-known technique in user interface design (for evidence, see section 6 of "A Summary of Principles for User-Interface Design").

Section 6 of "A Summary of Principles for User-Interface Design" discloses examples of shortcuts such as commands invoked by name, menu bar, modified keystroke combination, keystroke, or macros. The relevance of the disclosure of section 6 to the claimed subject matter

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of “immediately and automatically presenting a user selectable option through the camera menu, on capturing an image, for entering the database software application while remaining in the camera menu” is not understood.

From Manual of Patent Examining Procedure section 2144.04, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” **The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.**)

In Applicant’s claimed invention, “immediately and automatically presenting a user selectable option through the camera menu, on capturing an image, for entering the database software application while remaining in the camera menu” is not “an automatic or mechanical means to replace a manual activity” but represents a rearrangement of processing steps.

Applicant has disclosed in his Background of the Invention section, the state of the art and a problem with that art, as follows:

Digital cameras are now commonly used with mobile cellular telephones, personal digital assistants and personal computers. The digital camera may be connected to or integrated with such devices.

Typically when a picture is taken and an image captured by the camera, the image is by default automatically stored in a picture folder with other stored images. A viewer application can be used to view the images e.g. as a photo album.

These devices also typically have database applications that allow the organisation of personal data such as contact details. It would be desirable to take advantage of the presence of a digital camera to improve the usability of such database applications. The database application could include a plurality of entries, where each entry has not only one or more alphanumeric text fields but also one or more image fields. The database application may, as an example, be ‘Contacts’ with a database entry having alphanumeric text fields for the Name, Address, telephone

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number, email address etc of a person and an image field, for displaying a picture of that person.

It would be desirable enable a user to easily use a captured image as an image field of an entry of the database.

Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to “immediately” present a user-selectable option “through the camera menu, on capturing an image, for entering the database software application while remaining in the camera menu.”

Applicant has disclosed immediately presenting a user-selectable option in the following two passages.

Column 5, lines 23-27, of Applicant’s application discloses as follows:

After selecting ‘Capture’ and capturing an image, the image is by default automatically stored in the image memory 28 for access using the image viewing application (Gallery). The camera control application immediately presents the following user-selectable options on capturing an image: ‘new image’, ‘add to phonebook’, ‘delete’, ‘send’, ‘rename image’, ‘go to gallery’, ‘settings’, ‘help’ and ‘exit’.

Column 6, lines 6-10, of Applicant’s application discloses as follows:

The camera control application therefore immediately presents a plurality of user selectable options, on capturing an image, including an option for using the captured image as an image field of an entry of the database (the ‘add to phonebook’ option). The presentation is immediate in the sense that it is automatic (it does not require further user action) and fast (without a significant delay).

As to the meaning of “immediately,” Applicant asserts that this term is clear and adequately described, especially in the second passage above where it discloses that “the presentation is immediate in the sense that it is automatic (it does not require further user action) and fast (without a significant delay).” The ordinary dictionary definition of immediately is “without delay,” “with no intermediary; directly,” and “as soon as.”

Applicant does not agree that it would have been obvious to provide for this feature in light of Issue 4EN.

Page 50 of Issue 4EN shows a camera viewer with the word options in the lower left corner. The caption of the picture indicates options before taking a picture include capture, go to images, settings, and exit. In the right margin of page 51 of Issue 4EN, it is stated that options after taking a picture include new image, send, rename image, go to images, settings, and exit.

Second, the claimed invention is directed to “taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu,” which, as understood by Applicant, has not been done in the prior art, including Issue 4EN. This claimed feature runs counter to what one of ordinary skill would take a picture, store the picture, exit a camera mode and access a phonebook, and then assign the picture to a contact.

In pages 50-57 of Issue 4EN, the camera mode is discussed first and the images mode is discussed thereafter. On page 51 of Issue 4EN, in the right hand margin, an option after picture taking is “go to images.” Presumably, one leaves camera mode and enters image mode upon selection of “go to images” in the camera mode. There is no disclosure in pages 50-57 of Issue 4EN of **“taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu.”**

The Patent Office on page 5, lines 1-3, of the April 28, 2009 Office Action acknowledged that Issue 4EN does not disclose “taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu” in asserting as follows:

Nokia does not explicitly teach wherein the camera control application provides for taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu.

Third, the Patent Office has failed to address the claimed subject matter of “presenting a user selectable option **through the camera menu**, on capturing an image, for entering the database software application **while remaining in the camera menu.**” As such, the Office Action dated April 28, 2009 is incomplete and Applicant, thus, requests that the Patent Office not make a next Office Action a final office action.

Regarding the second point, the Patent Office asserted that LG remedies the acknowledged deficiency of Issue 4EN by asserting:

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However, LG teaches wherein the camera control application provides for taking a picture and then assigning the picture from a camera menu instead of from a phonebook menu (see page 51, "Set as... Contacts").

Issue 4EN teaches how to capture an image. Issue 4EN does not teach having an option for setting the image as a detail to a contact in phone book. [Issue 4EN, page 50] According to Issue 4EN, it is only possible to add an image if the user is in the contacts application, not from the camera application right after taking the image. [Issue 4EN, page 42] Issue 4EN teaches only how to save an image and how to send it [Issue 4EN, page 53], but fails to teach attaching the picture to a contact. So, Issue 4EN discloses only how to take an image and then send it and how to attach an image to a contact when the user is using the contacts application. Issue 4EN fails to teach how to take a picture and while in the camera application, to be able to assign the picture to a contact without actually launching the contacts application.

LG on page 51 teaches how to assign the picture to a contact after the user has opened the image gallery. On page 51, LG explicitly states, under the Gallery (Menu) heading, that the gallery "allows you to view photos that are stored in the phone." In step 1, from the gallery menu a user may select camera. In step 2, the user may then select gallery. In step 3, the list in the gallery may be used. In step 4, a user may select from several options including "send," "online album," "set as ...contacts," "enlarge," "lock," and "rename."

In Applicant's disclosure, it is not needed to open the gallery at all. [Applicant's disclosure, page 5, lines 18-27]. Furthermore, LG, as well as Issue 4EN, fail to disclose or suggest "presenting a user selectable option **through the camera menu**, on capturing an image, for entering the database software application **while remaining in the camera menu**." Even if step 1 relates to a camera menu selection, there is no disclosure on page 51 of LG of "presenting a user selectable option through the camera menu, on capturing an image" because LG explicitly states, under the Gallery (Menu) heading, that the gallery "allows you to view photos that are stored in the phone."

As neither LG nor Issue 4EN disclose or suggest this claimed subject matter, any purported combination of these references would fail to make obvious "presenting a user

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selectable option **through the camera menu**, on capturing an image, for entering the database software application **while remaining in the camera menu.**”

Thus, claim 20 is not made obvious by Issue 4EN in view of LG.

Aside from claim 20, the only other independent claims are claims 29, 31, and 35.

Claim 29 recites as follows:

A method comprising: for controlling an electronic device, the electronic device having a digital camera and a user input device, the method performing operations of: capturing an image via a digital camera by a selection of an option presented via a camera menu displayed on a user interface provided by a camera control software application; **immediately and automatically upon capturing the image, providing, through the camera control software application, a user-selectable option through the user interface for entering the captured image as an image field for a contacts entry maintained by a database software application and providing a user-selectable option through the user interface to cause a image viewing software application to access the captured image, wherein the camera control software application provides for taking a picture and then assigning the picture from the camera menu instead of from a phonebook menu; and upon selecting a user-selectable option via the camera menu for entering the captured image as an image field for the contacts entry, while remaining in the camera menu, causing the database software application to save the captured image in a database as an image field for the contacts entry, wherein functionality of the camera menu is provided by the camera control software application and wherein functionality of the phonebook menu is provided by the database software application.**

Claim 31 recites as follows:

An apparatus comprising: a camera control software application; a database software application; an image viewing software application; a digital camera; an input including soft keys; a memory configured to store the database, camera control software application, the database software application, and the image viewing software application; a display configured to provide a user interface; and a processor configured to control the digital camera and the display, configured to access the memory, configured to receive information through the input, and configured to execute the camera, database, and image viewing software applications retrieved from the memory, wherein the camera control

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software application is configured to enable a user to capture an image via the digital camera through an option displayed via a camera menu on the user interface and, **immediately and automatically after capturing the image, to present via the camera menu on the user interface a plurality of user selectable options including an option to add the captured image to a database that is accessible by the database software application, while remaining within the camera control software application, and including an option to invoke the image viewing software application to access the captured image, wherein the user selectable options are selectable by the user through corresponding ones of the soft keys, wherein the camera control software application provides for taking a picture and then assigning the picture from the camera menu instead of from a phonebook menu, wherein functionality of the camera menu is provided by the camera control software application and wherein functionality of the phonebook menu is provided by the database software application.**

Claim 35 recites as follows:

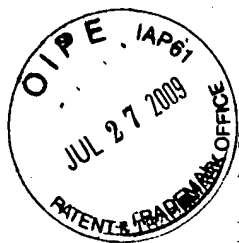
A user interface, comprising: a display; and an input comprising a plurality of soft keys, and configured to enable a user to, in cooperation with a camera control software application, capture an image via a digital camera through an option displayed on a camera menu on the user interface and, **immediately and automatically after capturing the image, to present a plurality of user selectable options through the camera menu including an option to add the captured image to a database that is accessible by a database software application, while remaining within the camera control software application, and comprising an option to invoke an image viewing software application to access the captured image, wherein the user selectable options are selectable by the user through corresponding ones of the plurality of soft keys, wherein the camera control software application provides for taking a picture and then assigning the picture from the camera menu instead of from a phonebook menu, wherein functionality of the camera menu is provided by the camera control software application and wherein functionality of the phonebook menu is provided by the database software application.**

As claims 29, 31, and 35 recite subject matter similar to that recited by claim 20, these claims are allowable for similar reasons for the allowability of claim 20.

Because claims 8-11, 13, 14, 30, 32-34, 36, and 37 depend from allowable claims, these claims are allowable also.

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The Patent Office is respectfully requested to reconsider and withdraw the rejections of the claims 8-11, 13, 14, 20, and 29-37 under 35 U.S.C. 103(a) based on Nokia 7650 User's Guide, Issue 4EN, in view of LG, and to allow all of the pending claims 8-11, 13, 14, 20, and 29-37 as now presented for examination. An early notification of the allowability of claims 8-11, 13, 14, 20, and 29-37 is earnestly solicited.



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Respectfully submitted:

Walter J. Malinowski July 23, 2009
Walter J. Malinowski Date

Reg. No.: 43423

Customer No.: 29683

HARRINGTON & SMITH, PC
4 Research Drive
Shelton, CT 06484-6212

Telephone: (203) 925-9400, extension 19

Facsimile: (203) 944-0245

email: wmalinowski@hspatent.com

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